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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,372	08/21/2003	James L. Cook	UMO 1555	7442

321 7590 04/18/2007  
SENNIGER POWERS  
ONE METROPOLITAN SQUARE  
16TH FLOOR  
ST LOUIS, MO 63102

EXAMINER
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WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/18/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/18/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspatents@senniger.com

ED

**Office Action Summary**

Application No.

10/645,372

Applicant(s)

COOK ET AL.

Examiner

Dave Willse

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

The examiner apologizes for the excessive delay in the present Office action.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-12, and 14-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dee, GB 1 528 906, which discloses a humeral component **10** comprising a spool **11** having a contoured external surface **13** (Figures 2 and 4) and sized and shaped to fit within a recess cut between medial and lateral aspects of a humeral condyle (Figure 8; page 3, line 71) and a radioulnar component comprising a body **31** having a generally U-shaped contour (Figures 5, 7, and 9) with an inner peripheral surface **33** defining an articular surface (page 3, lines 31-32) sized and shaped for engagement with surface **13** (Figures 8 and 9; page 3, lines 30-45). The further limitations of claims 2 and 3 would have been inherent in the modification proposed at page 3, lines 116-119. Regarding claim 7 and others, although the grooves **19** and **20** are apparently intended to receive cement (page 3, lines 13-18; page 2, lines 26-30), these recessed configurations, along with other cavities depicted in Figure 4, are *capable* of receiving bone. Regarding claim 10 and others, the “screw or equivalent member” (page 2, lines 22-23) can be viewed as a threaded peg. Regarding claim 11, element **14** (Figures 2, 4, and 8) is seen as a

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panel. Regarding claim 12, the annular portion defining the outer boundary of the groove 19 (Figure 4) is interpreted as a second panel.


Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dee, GB 1 528 906. Regarding claim 4, guides for locating surgical cuts to remove portions of a humerus and ulna for aligning an endoprosthesis elbow with the physiological center of natural elbow rotation were well known in the art and would have been obvious to the ordinary practitioner from the discussion at page 3, lines 66-76. Regarding claim 13, cleats would have been obvious in order to enhance securement, particularly prior to cement hardening.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dee, GB 1 528 906, in view of Dee, GB 1 452 924. Medullary stems were common in the art, as seen in Dee '924, for example, and would have been an obvious variant in order to further bolster the affixation to the humerus, with motivation having been provided by the explicit references to Dee '924 at page 1, line 37, and page 3, line 116, of Dee '906.

The Applicant's remarks have been considered. The Applicant questions whether there is "any rule or suggestion that requires the applicant to specifically point out support in the specification for amendments to the claims and newly added claims" (Applicant's reply of April 24, 2006: first sentence of the footnote on page 1). As seen, for example, from MPEP § 2163.06, section III, first sentence, "[t]he claims as filed in the original specification are part of the disclosure". Therefore, any amendments made to the claims constitute "amendments made to the disclosure" (MPEP § 2163.06, section I, last sentence). The Applicant's comments of January 5, 2006, have been reviewed but are deemed to be moot in view of the new grounds of rejection set forth above.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762 and who is generally available Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



**Dave Willse**  
**Primary Examiner**  
**Art Unit 3738**